



RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 1647

PATENT
Customer No. 22,852
Attorney Docket No. 2356.0073-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Sebastian SUERBAUM et al.) Group Art Unit: 1647
Application No.: 09/015,078) Examiner: S. TURNER
Filed: January 29, 1998)
CPA Filed: July 27, 2001)
For: CLONING AND CHARACTERIZATION)
OF THE *flbA* GENE OF *H. PYLORI*,)
PRODUCTION OF AFLAGELLATE)
STRAINS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY TO ADVISORY ACTION

Applicants now reply to the Advisory Action mailed October 16, 2003. In the Advisory Action, the Office entered the amendment, but maintained all rejections for the reasons of record, indicating that Applicant's Declaration Under 37 C.F.R. § 1.132 was not found persuasive.

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In particular, the Office contended that the Declaration failed to appropriately designate (1) the affiliated country and (2) the inventors of the claims. In making this rejection, the Office cited 37 C.F.R. § 1.131. (Advisory Action at page 2.)

In an effort to facilitate prosecution, Applicants now submit a revised Declaration under 37 C.F.R. § 1.132. The revised Declaration (1) explicitly designates the affiliated country, and (2) is signed by both Applicants, Sebastian Suerbaum and Agnès Labigne. Applicants respectfully submit that these revisions place the Application in condition for Allowance. However, Applicants respectfully traverse the Office's position that these revisions were necessary.

Applicants are unaware of any Office rules or regulations indicating that a § 1.132 Declaration must designate the affiliated country; indeed, it is Office practice to accept Declarations under 37 C.F.R. § 1.132 that *do not* designate the affiliated country. For example, in this application's parent, U.S. patent application Serial No. 09/015,078, the Office (and in fact the same Examiner) accepted a § 1.132 Declaration that did not designate the affiliated country to overcome identical prior art. (Exhibit 1.)

Applicants are also unaware of any Office rules or regulations that indicate that a § 1.132 Declaration must be signed by more than a single inventor. In fact, when a prior art reference has co-extensive authors with the applicants of a pending application, the C.C.P.A. has stated that the declaration of a *single* applicant "provides a clear alternative conclusion" to the Office's inference that the authors of a prior art publication constituted the work of others. See *In re Katz*, 215 U.S.P.Q. 14, 18 (C.C.P.A. 1982). Moreover, as shown in Exhibit 1, the Office (and in fact the same Examiner) accepted a § 1.132 Declaration in the parent application signed by a single inventor.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 3, 2004

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Attachments: Exhibit 1.

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